

Remarks

After careful consideration of the outstanding Office Action, this application has been amended accordingly and favorable reconsideration on the merits thereof is at this time respectfully requested.

The undersigned will consider the comments and rejections chronologically as set forth in the outstanding Office Action beginning at page. Under the caption "Response to Arguments," the Examiner states that Applicant's arguments with respect to claim 17 "are moot in view of the new ground(s) of rejection," and though not applying the patents to Herrmann et al. (5,406,894) and Maier et al. (France 91 04 111), the Examiner disagrees and concludes that the subject matter of **original** claim 17 "is an obvious mater [sic] of design choice for one having an ordinary skill in the art [sic]." Quite frankly, if the Examiner believes the position espoused under the paragraph captioned "Response to Arguments" is correct, claim 17, as amended, should have been rejected over the Herrmann et al. and Maier et al. patents. Insofar as the undersigned is concerned, if the Examiner is correct in his views with respect to original claim 17, such should be equally applicable to amended claim 17, but amended claim 17 was not rejected. Accordingly, upon considering this response, the Examiner is requested to either (1) reject claim 17 based upon the patents to Herrmann et al. and Maier et al. or (2) specifically indicate that claim 17 of record is directed to unobvious subject matter over the latter patents.

Additionally, the Examiner has made several comments in the paragraph under the caption "Response to Arguments" which require rebuttal.

First, the patent to Maier et al. does, in fact, disclose a glass plate "with a surrounding frame which is "safe and sturdy and prevents spills running over the edge." The Examiner states he "disagrees because Herrmann teaches that it is well known to provide a plate or shelf with a partial, front and rear edge frame or trim." First of all, Maier et al. specifically discloses an endless frame or border to ensure that spills do not run over the edge and Herrmann et al. is totally unconcerned with spillage. Therefore, whether Herrmann et al. discloses a shelf having a piece of trim thereon is totally irrelevant.

Secondly, the conjunctive "or" used by the Examiner in reference to a "front and rear edge frame **or** trim" is completely erroneous. Herrmann et al. does not disclose a "rear edge frame" only "trim." If the Examiner is suggesting that a "frame" and "trim" in shelf art is one and the same, he must provide evidence thereof by prior art or his own affidavit. Either would be appreciated.

Thirdly, the statement "trim is more than decorative" is wrong because the function thereof is not one of protection. Plate glass is edge-ground and tempered and it is as safe and as sturdy as it can be, with or without trim. At column 5, between lines 8 and 10 of the Herrmann et al. patent is found the statement:

Front trim 60 and a rear trim piece 84 may be optionally included or deleted, depending upon specific shelving application and stylistic requirements (FIGURES 9-10)."

Nowhere is safety or sturdiness suggested or mentioned in this patent, but the Examiner's argument does not address the traversal of the rejection based upon these patents set forth in the last two amendments. More

specifically, the undersigned incorporates hereat by reference the totality of the "Remarks" beginning at page 3 and continuing through page 5 of the Supplemental Amendment certificate of mailed on March 25, 2003. The gist of the argument is that a person skilled in the art would not destroy the "beneficial" function of the "peripheral rim" of Maier et al. which prevents the accidental spill of liquid from running over the edge of the shelf by the Examiner's allegation that Herrmann et al. would motivate a person in the art to "provide trim while leaving the edge portion untrimmed." The latter was said by the undersigned to be a "complete destruction of the Maier et al. patent virtually rendering the shelf thereof inoperative for its intended purposes (strength and spillage confinement)," and such would not be done by a person skilled in the shelf art under the guise of obviousness. The latter reasoned traversal has not be countered in any rationale fashion by the Examiner's comments appearing under the caption "Response to Arguments."

Finally, the Examiner states: "It is well settled in case law that to remove an element, in this case the side edge rim, and its function, spill resistance, is an obvious mater [sic] of design choice for one having an ordinary skill in the art [sic]." The case law is rather specific, just as the Examiner described, namely, the omission of **an element** and the elimination of **its contemporaneous function** might well be obvious to a person skilled in the art. However, nowhere in case law is there a basis holding that the **partial removal** of an element and **the destruction** of its attendant function is at any time obvious. The Examiner's attention is directed to Section 2144.04 of the MPEP and the cases cited therein, each of which deals with the **omission of an element, not part of an element,**

and its function. The Examiner's suggestion that "the side edge rim" is the removal of "an element" is a gross mischaracterization of both the fact (definition of an element) and the law (omission thereof). With due respect, the entirety of the Examiner's espoused reasons for disagreeing with Applicant and the unobviousness of claim 17, as set forth in the "Response to Arguments," are erroneous and untenable. Accordingly, the complete withdrawal on the record of the statements by the allowance of claim 17 is respectfully requested.

The withdrawal of claims 20, 21 and 28 through 36 from consideration has been noted.

The rejection of claims 62 through 65 under 35 U.S.C. § 112, first paragraph, is noted. The subject matter of these claims will be prosecuted by way of a divisional/continuation-in-part application. Should the Examiner determine that this application is otherwise in condition for allowance, he is herewith authorized to cancel claims 62 through 65 by Examiner's Amendment.

At the bottom of page 3, the Examiner rejected claims 1 through 19, 22-27 and 47-61 "under 35 U.S.C. 112, second paragraph, as being indefinite." All of the claims requiring amendment have been appropriately amended except for claims 18 and 19 which have been objected to because of the phrase "said side edge corner portions." The latter-quoted phrase lacks antecedent basis because such is not required. To paraphrase claim 18, the "glass piece front and rear edges" define with the "side edges" the "corner portions" of the glass piece. In other words, the glass piece front and rear edges define with the side edges ... corner portions of the glass

piece. When thus interpreted, there is no reason to reject claims 18 and 19 on the ground of lack of proper antecedent basis.

Claims 17 through 19 and 22 through 27 were also rejected under 35 U.S.C.112, second paragraph, "as being incomplete for omitting essential elements." Claim 17 has been amended to define "a lower support surface adapted for sliding support in an associated refrigerator compartment." Thus, the lower support surface provides the sliding support and thereby defines "sliding structure." Similarly, the word "conductivity" has been changed to -- air flow --, and this change corresponds to the specification and the Examiner's utilization of like language at the top of page 4, first complete sentence thereof. Therefore, the withdrawal of the rejection of claims 17-19 and 22-27 would be most appreciated.

The final issue of record is the rejection of claims 1, 2 and 17 "under 35 U.S.C. 102(b) as being clearly anticipated by Poulsen" (4,923,260) which the Examiner states "shows a shelf 33 with front and rear borders 39 and 27," respectively. "A prior art reference anticipates a claim, and thus invalidates it under 35 U.S.C. § 102, if that reference discloses each and every element of the claim." (See Stoller v. Ford Motor Co., 18 USPQ 2d 1545, 1546; Richardson v. Suzuki Motor, Co., 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir.).)

Where in the Poulsen patent does the same disclose a refrigerator compartment having "a plurality of substantially vertically spaced shelf-supporting ledges along each of said side walls" (claim 1)? Where in the Poulsen patent is there found "said at least one slidable shelf being disposed with said front and rear border members in sliding relationship to one of said front and rear border members in sliding relationship to one of said

horizontally aligned pair of shelf-supporting ledges with said piece of glass being thereby spaced above said horizontally aligned pair of shelf-supporting ledges"? With due respect, claim 1 stands totally inappropriately rejected under 35 U.S.C. § 102(b), and is likewise clearly unobvious (35 U.S.C. § 103(a)) over the Poulsen disclosure.

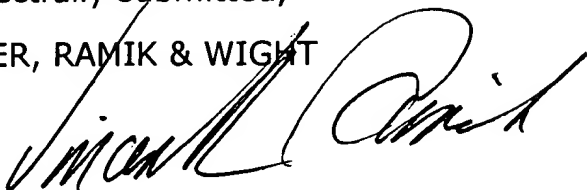
With respect to claim 17, the claim has been amended, as noted earlier, to provide basis for the claimed "slidable shelf" through the "lower support surface" which is adapted for "sliding support in an associated refrigerator compartment," all lacking in the Poulsen patent. Furthermore, the word "slidable" in the preamble of claim 17 cannot be discarded, nor can the more specific limitation of the "lower support surface adapted to sliding support in an associated refrigerator compartment." (See (Kropa v. Robie, 187 F.2d 150, 152, 88USPQ 478, 481 (CCPA 1951).)

In view thereof, the formal allowance of claim 17 is considered proper and would be most appreciated.

As was noted earlier herein, if the Examiner allows all of the claims of record except for claims 62 through 65, the latter claims may be cancelled by Examiner's Amendment. However, if upon consideration of this amendment, the Examiner intends to reject any of the claims of record, excluding claims 62 through 65, he is requested to telephone the undersigned in order that a personal interview can be arranged with the

Examiner. The undersigned will attempt to accommodate the Examiner's scheduling.

Respectfully submitted,
DILLER, RAMIK & WIGHT

By: 

Vincent L. Ramik, Reg. No. 20,663

7345 McWhorter Place
Suite 101
Annandale, VA 22003

(703) 642-5705 - phone
(703) 642-2117 - fax

e-mail: DRWPATENTLAW@AOL.COM